



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

SW

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,219	12/15/2001	Joseph Edward Carchidi	AS-01-03	1131
7590	08/27/2004		EXAMINER	
John A. Haug P.O. Box 386 West Harwich, MA 02671			DAVIS, DANIEL J	
			ART UNIT	PAPER NUMBER
			3731	
DATE MAILED: 08/27/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/017,219

Applicant(s)CARCHIDI ET AL. **Examiner**

D. Jacob Davis

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Amendment July 22, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-14 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 9-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 5 recites, "a weakened portion is formed *between* the tip portion and the body."

Claim 6 contradicts claim 5 by reciting, "the weakened portion is formed by opposing slots formed *in* the tip portion." The weakened portion cannot be located both *in* the tip portion and *between* the tip portion and the body.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Carchidi et al. (US 5,899,940). In Fig. 1, Carchidi clearly anticipates the anchoring screw body 12 and the elongated generally cylindrical member 16. The reaction element 14 has a flat surface, comprising the distal most surface of the reaction element 14. The surface portion is generally perpendicular to the longitudinal axis of the screw body and the cylindrical member. The flat surface portion extends approximately twice the diameter of the distal end 16e of the elongated generally cylindrical member and a distance greater than the diameter of the distal end of the elongated generally cylindrical member.

Claims 1 and 5-8 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,325,803 to Schumacher et al. In Figs. 1-4 and 16, Schumacher discloses an anchoring screw body 32 having internal and external threads (Fig. 5). The device comprises an elongated cylindrical member 30 having a head 34. The head 34 includes a driving surface, a reaction element 110 having a flat surface portion with a relatively wide mesh body having a plurality of holes therethrough, and a solid tip portion also having a flat surface portion. The driving surface may be driven by a hammer, for example. The solid tip portion may comprise any one of the solid corners of the reaction element 110. The larger holes of the reaction element 110 create a weakened portion. The weakened portion is located in either a width or length direction along the center of the larger holes, which oppose one another.

The device meets the structural limitations of the claims and is inherently capable of being used as a maxillofacial anchoring and distraction system. Examiner interprets the phrase, "to serve as" to mean "capable of serving as." Furthermore, it is not requisite that the reaction element be placed against the engagement surface, only that the devices be capable of interacting in such a manner.

Regarding claim 8, "the flat surface portion extends approximately twice the diameter of the distal end of the elongated generally cylindrical member," is an open ended limitation. To meet the claim limitation, the flat surface portion may be longer than twice the diameter of the distal end of the elongated generally cylindrical member since some portion of the flat surface portion is twice as long as the elongated generally cylindrical member.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(c) which forms the basis for all obviousness rejections set forth in this Office action:

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claim 4 is rejected under 35 U.S.C. 103(c) as being unpatentable over U.S. Patent No. 6,325,803 to Schumacher et al. in view of U.S. Patent No. 5,709,686 to Talos et al. Schumacher discloses round holes, which enable a screw to be perpendicularly and accurately fastened within the bone. The patent fails to disclose elongated holes in addition to the present round holes. Talos teaches elongated holes

Art Unit: 3731

in Figs. 2A and 2B, which enable a screw to be anchored at a slant within the bone. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Schumacher device 110 to make some of the round holes elongated in order to enable a screw to be anchored at a slant within the bone.

Response to Arguments

Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new grounds of rejection. Amended claim 7 fails to overcome the Carchidi reference since the flat surface portion of the reaction element, as illustrated in Fig. 1, "extend[s] along a selected axis a distance greater than the diameter of the distal end of the elongated generally cylindrical member."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Jacob Davis whose telephone number is (703) 305-1232. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott or Shaver can be reached on (703) 308-0858. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DJD

A handwritten signature in black ink that reads "Julian W. Woo". The signature is written in a cursive, flowing style.

JULIAN W. WOO
PRIMARY EXAMINER